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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/686,546  | 10/14/2003  | Monte G. Rydalch     | 020366-092800US     | 3481             |
| 20350   | 7590        | 09/21/2005           | EXAMINER            |                  |
| TOWNSEND AND TOWNSEND AND CREW, LLP<br>TWO EMBARCADERO CENTER<br>EIGHTH FLOOR<br>SAN FRANCISCO, CA 94111-3834 |             |                      | DONDERO, WILLIAM E  |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3654                |                  |

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                |                   |
|------------------------------|--------------------------------|-------------------|
| <b>Office Action Summary</b> | Application No.                | Applicant(s)      |
|                              | 10/686,546                     | RYDALCH, MONTE G. |
|                              | Examiner<br>William E. Dondero | Art Unit<br>3654  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 August 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7 and 9-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7 and 9-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 8/19/2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Thornbury. Regarding Claim 1, Thornbury discloses a tool comprising a proximal portion have a first flange 16 connected with a shaft 48 extending from the flange and adapted for engagement with a powered mechanical rotation device 60, a distal portion having a second flange 14, a column 12 coupled with one 16 of the proximal and distal portions and detachably engaged with the other 14 of the proximal and distal portions, the column including a cavity 22 adapted to grip the filament and disposed such that the cavity is between the first and second flanges when the column is engaged with the other of the proximal and distal portions (Figures 2 and 3). The recitation of "a tool for opening a cable having a length of filament disposed within a sheath" is not given weight as it is merely intended use and does not add structure to the tool. Regarding Claim 2, Thornbury discloses the column fixedly coupled with the proximal portion 16 (Figures 2 and 3). Regarding Claim 3, Thornbury discloses the column 12 comprises a hollow interior and the cavity 22 comprises a hole extending through the surface of the column to the hollow interior (Figures 2 and 3; and column 1, line 67). Regarding Claim 4, Thornbury discloses the cavity comprising a plurality of cavities 22 and 24, each

being adapted to grip the filament. Regarding Claim 5, Thornbury discloses the powered mechanical rotation device 60 is a hand-held drill (Figures 2 and 3; and column 3, lines 46-49).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thornbury in view of Bulman. Thornbury discloses a tool as discussed above in regards to Claim 1. Thornbury is silent about the first flange comprising a threaded hole and the column being threaded on the proximal end. However, Bulman teaches a first flange 14 comprising a threaded hole 30 and the column 12 being threaded at the proximal end 18 (Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to thread a hole and the column end of Thornbury's tool as taught by Bulman to allow for easy disassembly of the tool for removing the filament.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thornbury in view of Bulman. Thornbury discloses a tool as discussed above in regards to Claim 1. Thornbury is silent about the second flange comprising a threaded hole and the column being threaded on the proximal end. However, Bulman discloses a second flange 14 comprising a threaded hole 30 and the column 12 being threaded at the distal end 18 (Figure 2). It would have been obvious to one of ordinary skill in the art at the

time the invention was made to thread a hole and the column end of Thornbury's tool as taught by Bulman to allow for easy disassembly of the tool for removing the filament.

Claim 9-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiano in view of Thornbury. Regarding Claims 9 and 14, Tiano discloses a method for opening a cable having a length of filament within a sheath, comprising attaching an end of the filament 32 to a tool having a column 12 disposed between two flanges; and thereafter, rotating the column to pull the filament from the sheath and to spool the filament about the column (Figures 2, 3, and Claim 9). Tiano is silent about a cavity adapted to grip the filament and separating one of the flanges from the column to release the spooled filament. However, Thornbury discloses a portable winding device with a cavity 22 and a detachable second flange 14 (Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Thornbury's cavity and detachable second flange to grip the filament and remove the spooled filament from the tool, respectively, because these steps would result from the use of device of Tiano in view of Thornbury in its normal and expected fashion to allow the spool to be emptied and continue spooling the rest of the filament from the sheath. Regarding Claim 10, Tiano discloses rotating the column comprises rotating the column with a powered mechanical rotation device T engaged with the tool (Figures 2 and 3). Regarding Claim 11, Tiano discloses the powered mechanical rotation device T is a hand-help drill (Figures 2, 3). Regarding Claim 12, Tiano discloses the tool has a shaft 22 extending from a first of the flanges; and rotating the column comprises rotating the

shaft 22 with a powered mechanical rotating device T engaged with the shaft 22 (Figures 2 and 3).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiano in view of Thornbury as applied to claims 9 and 12 above, and further in view of Bulman. Tiano in view of Thornbury disclose a method for opening a cable as discussed above in regards to Claims 9 and 12. Tiano in view of Thornbury is silent about separating the first of the flanges from the column. However, Bulman discloses a detachable first flange 14 (Figure 2). It would have been obvious to one of ordinary skill in the art to use Bulman's detachable first flange in the method of Tiano in view of Thornbury to separate the flange from the column and remove the spooled fiber because this step would result from the use of device of Tiano in view of Thornbury in further view of Bulman in its normal and expected fashion.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiano in view of Thornbury as applied to claim 9 above, and further in view of Bulman. Tiano in view of Thornbury discloses a method for opening a cable as discussed above in regards to Claim 9. Tiano in view of Thornbury is silent about one of the flanges comprising a threaded hole into which a threaded end of the column is screwed; and separating the one of the flanges from the column comprising unscrewing the column relative to the one of the flanges. However, Bulman discloses a flange 14 comprising a threaded hole 30 into which a threaded end 18 of the column 12 is screwed (Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Bulman's threaded flange and column in the method of Tiano in view

of Thornbury to separate the flange and column for removal of the filament by unscrewing the column relative to the one of the flanges because this step would result from the use of device of Tiano in view of Thornbury in further view of Bulman in its normal and expected fashion.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiano in view of Thornbury as applied to claim 9 above, and further in view of applicant's admitted prior art. Tiano in view of Thornbury discloses a method for opening a cable as discussed above in regards to Claim 9. Tiano in view of Thornbury is silent about the filament comprising a strength member of an optical-fiber cable. However, the applicant's prior art discloses the use of strengthening members of fiber optic cables on page 2, paragraph 2, lines 16-18. It would have been obvious to use the method of Tiano in view of Thornbury to remove a strength member from an optical-fiber cable because this step would result from the use of device of Tiano in view of Thornbury in its normal and expected fashion

Claim 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiano in view of Thornbury. Regarding Claim 17, Tiano discloses a system for opening a cable having a length of filament 32 within a sheath 30 comprising a means for gripping an end of the filament 13; a means for extracting the filament 32 from within the sheath 30 and for spooling the extracted filament; and a means for confining the filament, flanges at each end of the longitudinal region 12, to a longitudinal region 12 as the filament is spooled (Figures 2 and 3). Tiano is silent about a means for removing the means for confining to release the spooled filament from the longitudinal region.

However, Thornbury teaches a flange 14 detachable from a longitudinal region (Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make one of Tiano's flanges detachable as taught by Thornbury as the means for removing the means for confining to allow for the removal of the spooled filament.

Regarding Claim 18, Tiano in view of Thornbury discloses a system for opening a cable as discussed above in regards to Claim 17. Further, Thornbury discloses the means for gripping the end of the filament comprises a cavity 22 in a column 12 about which the filament is spooled (Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Thornbury's cavity to Tiano's column to grip the filament.

Regarding Claim 19, Tiano in view of Thornbury discloses a system for opening a cable as discussed above in regards to Claims 17 and 18. Tiano further discloses the means for extracting the filament from within the sheath and for spooling the extracted filament comprise a means for rotating the column 12 about an axis of the column 12, the drill T and shaft 22 (Figures 1 and 2).

Regarding Claim 20, Tiano in view of Thornbury discloses a system for opening a cable as discussed above in regards to Claim 17, 18, and 19. Further Tiano discloses the means for confining the filament comprises first and second flanges disposed at positions along the axis (Figures 2 and 3). Tiano is silent about the cavity being disposed between the first and second flanges; and at least one of the first and second flanges being removable from the column. However, Thornbury discloses the cavity 22

disposed between the first 16 and second 14 flanges; and the second flange 14 is removable from the column 12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Thornbury's cavity and removable flange to grip the filament and remove the spooled material, respectively.

***Response to Arguments***

Applicant's arguments filed August 19, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention (see Remarks on page 8-9, section 2a), it is noted that the features upon which applicant relies (i.e., detachably engaged) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine the references (see Remarks on page 9-10, section 2b, paragraphs 1 and 2), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tiano's tool for ripping a ripcord and

Thornbury's kite reel could be combined by one of ordinary skill in the art as they are both portable tools for winding an elongated element.

In response to applicant's argument that the teaching of Tiano and Thornbury may not be combined (see Remarks on page 10, section 2b, paragraph 3), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the references fail to show certain features of applicant's invention (see Remarks on page 10, section 2b, paragraph 3), it is noted that the features upon which applicant relies (i.e., rugged, high-strength filaments) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Dondero whose telephone number is 571-272-5590. The examiner can normally be reached on Monday through Friday 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on 571-272-6951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

wed

  
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